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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,086	05/31/2001	Alexandra Debray	12406-008001	6405
7590	02/01/2005		EXAMINER	
Fish & Richardson 225 Franklin Street Boston, MA 02110-2804			COLON, GERMAN	
			ART UNIT	PAPER NUMBER
			2879	

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/786,086

Applicant(s)

DEBRAY ET AL.

Examiner

German Colón

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/3/05</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on September 17, 2004 has been entered.

### ***Specification***

2. The amendment filed September 17, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amended specification discloses a phosphor composition including Sc (scandium), while the original disclosure was related to a phosphor composition including Se (selenium). There is not sufficient evidence in the disclosure as originally filed, or in applicant remarks, to support that Sc was the intended element. (See Examiner's Response to Arguments, item #5, for a detailed description of the Examiner's position.)

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 13-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended independent claims 13, 27 and 28 recite the limitation of a luminescent material structure comprising Sc (scandium); however, the specification only provides support for Se (selenium). There is not sufficient evidence in the disclosure as originally filed, or in applicant remarks, to support that Sc was the intended element. (See Examiner's Response to Arguments, item #5, for a detailed description of the Examiner's position.)

Claims 14-26 are rejected because of their dependency status from claim 13.

***Response to Arguments***

5. Applicant's arguments filed September 17, 2004 have been fully considered but they are not persuasive.

Applicant argues that a typographical error occurred in the English translation of the German PCT application. Applicant provides the Abstract of the PCT application as evidenced of said typographical error, where it shows that Sc, and not Se, was the intended element.

The Examiner concedes that the Abstract of Application PCT/DE00/02405, clearly discloses Sc as part of the luminescent material. However, it is proper to consider not only the abstract of said application, but the reference as a whole. On at least page 3, line 10; page 11, line 3; and page 12, line 6, PCT application refers to Se, rather than Sc. The PCT application claims priority of German Application 199 63 791.1. This foreign priority discloses a luminescent material comprising Se (see at least Page 2, line 36; and Page 6, line 36).

Accordingly, if the whole history of the application is taken into consideration, the intended feature of the invention is a luminescent material comprising Se (selenium) and not Sc (scandium). Moreover, since Se appears a plurality of times in all the related applications, and Sc only appears once in the abstract of the PCT application, one of ordinary skill in the art would conclude that a typographical error occurred in the abstract of the PCT and not in the translation of the instant application. Thus, it is the Examiner's position that the recitation of Se in the application cannot be considered as a mere typo.

Applicant argues that it becomes clear to a person skilled in the art that "Se" has to be replaced by "Sc" because all the other disclosed elements are rare earth elements and due to its electron configuration.

This is not persuasive. First, the Examiner could not find in the disclosure where it is stated that the component 'A' of the garnet structure is a rare earth element. Second, assuming that the disclosure evidences said component 'A' being a rare earth element, the Examiner notes that "Sc", while associated with rare earth elements (Lanthanide Series or Actinide Series), is a transition metal. Following Applicant's position, "Se" may refer to "Fe", "Re" or "Sg". Further,

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while electron configuration is an important factor in the formation of compounds, it is not the only feature to consider.

For the reasons stated above the rejection to the claims and objection to the specification is deemed proper.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to German Colón whose telephone number is 571-272-2451. The examiner can normally be reached on Monday thru Thursday, from 8:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel can be reached on 571-272-2457. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SC  
gc

Karabi Guharay